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10/607,233	06/26/2003	Eric E. Blohm	077047-9497-00	5865
23409 7590 07/31/2007 MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202			EXAMINER BATTULA, PRADEEP CHOUDARY	
			ART UNIT 3722	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/607,233

Applicant(s)

BLOHM ET AL.

Examiner

Pradeep C. Battula

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 16 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 28-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This action is in reply to the response filed on May 16, 2007

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 21 – 23, 28 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Graushar.

In regards to Claim 21, Graushar discloses a binding method comprising: generating a mailing list of recipients; generating a pre-personalized printed product off-line for selected recipients on the mailing list; the ability to load the pre-personalized printed products adjacent the binding line (Figure 1, Item 14); assembling a book for each recipient including a respective pre-personalized printed product; rejecting selective recipients' books; and generating an alternate piece (it is generated at some point; it is not claimed when and how it is generated) in place of each rejected book the alternate piece being of a different medium than the pre-personalized printed product (Column 2, Lines 1 – 15, 50 – 67, and Column 3, Lines 1 – 4).

In regards to Claim 22, as applied to 21, Graushar further discloses (inherently) generic book does not have the pre-personalized signatures but since it does go to a particular individual it will have address information for the customer. Since it does not

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have all the pre-personalized information but does have pre-personalized information, it does have a portion pre-personalized information.

In regards to Claim 23, as applied to Claim 21, Graushar further discloses the act of generating a generic book to be sent to the selected recipients whose books, which were to include the pre-personalized printed products, were rejected (Column 3, Lines 1-3).

In regards to Claim 28, Graushar discloses a binding method comprising: generating a mailing list of recipients (Column 2, Lines 1 – 15); generating a pre-personalized printed product for each recipient (Column 2, Lines 50 – 52); assembling a book on a binding line for each recipient, each said book including the respective pre-personalized piece (Column 2, Lines 50 – 65); rejecting selective books (Column 2, Lines 66 – 67 → Column 3, Lines 1); removing the rejected books from respective spaces along the binding line (Column 2, Lines 66 – 67 → Column 3, Lines 1 – 4); generating an alternate pre-personalized [the generic book is present and is therefore generated at some point] piece for each recipient whose book was rejected (Column 3, Lines 1 – 4), the alternate pre-personalized piece being of a different medium than the pre-personalized printed product (Column 3, Lines 1 – 4; generic book is inherently not identical to original); and inserting the alternate pre-personalized piece into the space previously occupied by the respective rejected book (Column 3, Lines 1 – 4; inserted at 27 to take over the position).

In regards to Claim 30, as applied to Claim 28, Graushar does not disclose that the alternate piece is generated on the binding line and it is therefore inherent that it is done or can be done off the binding line.

2. Claim 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson.

In regards to Claim 24, Anderson discloses that it is known in the art to have a binding method comprising: generating a pre-personalized book on a binding line for a plurality of specific individuals, each pre-personalized book having therein a pre-personalized signature; rejecting selective pre-personalized books; reprinting the pre-personalized signature of one of the rejected book pre-personalized books and; then regenerating the rejected pre-personalized book on the binding line for the specific individual to include the reprinted pre-personalized signature (Column 1, Lines 37-65; Argument to Claim 1).

In regards to Claim 25, as applied to Claim 24, Anderson further discloses the step of reprinting the portion is done on the binding line (Column 1, Lines 58-63).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 7, 15 – 19, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar in view of Anderson.

1. In regards to Claim 1, Graushar discloses a binding method comprising: generating a pre-personalized book on a binding line for a specific individual (Column 2, Lines 50 – 52); rejecting selective pre-personalized books (Column 2, Lines 66 – 67 → Column 3, Lines 1; and putting an alternate piece of an alternate medium compared to the pre-personalized book in place of each rejected pre-personalized book to be delivered to the specific individual (Column 3, Lines 1 – 4):

Graushar does not disclose generating an alternate piece of an alternate medium.

Anderson discloses that it is well known to generate a pre-personalized book on a binding line for a specific individual; rejecting selective pre-personalized books; and generating an alternate piece in place of each rejected pre-personalized book to be delivered to the specific individual (Column 1, Lines 37-65). Furthermore Anderson discloses that certain feeders can be associated with particular books and that is how particular books are made for a person (Column 5, Lines 47 – 52). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to allow generation of the generic book using the particular feeders of Graushar in order to provide a customer with a replacement book which is still personalized.

In regards to Claim 2, as applied to Claim 1, Graushar modified by Anderson further discloses that the pre-personalized book includes pre-personalized information and the alternate piece includes the same pre-personalized information (Column 1, Lines 58-63; Anderson).

In regards to Claim 3, as applied to Claim 1, Graushar modified by Anderson further discloses that the pre-personalized book includes a pre-personalized signature (Column 1, Lines 8-10; Anderson).

In regards to Claim 4, as applied to Claim 1, Graushar modified by Anderson does not disclose that the alternate piece is generated on the binding line and it is therefore inherent that it is done or can be done off the binding line.

In regards to Claim 5, as applied to Claim 1, Graushar modified by Anderson further the act of generating the alternate piece includes printing the alternate piece on the binding line (Column 1, Lines 58-63; Anderson).

In regards to Claim 6, as applied to Claim 1, Graushar modified by Anderson further the alternate piece is a printed product (Column 1, Lines 58-63; Anderson).

In regards to Claim 7, as applied to Claim 6, Graushar modified by Anderson further an alternate piece that is a postcard (Column 1, Lines 58-63; Anderson).

In regards to Claim 15, Graushar discloses a method of replacing a rejected book on a binding line, the method comprising: generating a mailing list of recipients having a mailing order (Column 2, Lines 50 – 58; a list is made and therefore generated); assembling a pre-personalized book on the binding line for each recipient according to the mailing list (Column 2, Lines 52 – 65); rejecting selective pre-personalized books (Column 2, Lines 66 – 67 → Column 3, Lines 1 – 4); and replacing the rejected pre-personalized book with an alternate piece, the alternate piece positioned on the binding line to maintain the mailing order (Column 3, Lines 1 – 4; position 27 is still on the binding line; the book is generic and therefore of a different format).

Graushar does not disclose generating an alternate piece on the binding line, the alternate piece being of a format different from the rejected pre-personalized book.

Anderson discloses that it is well known to generate a mailing list of recipients; to generate a pre-personalized book on a binding line for a specific individual; rejecting selective pre-personalized books; and generating an alternate piece in place of each rejected pre-personalized book to be delivered to the specific individual (Column 1, Lines 37-65). Furthermore Anderson discloses that certain feeders can be associated with particular books and that is how particular books are made for a person (Column 5, Lines 47 – 52). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to allow generation of the generic book using the particular feeders of Graushar in order to provide an alternate piece and series of pre-personalized books in one process.

In regards to Claim 16, as applied to Claim 15, Graushar modified by Anderson further discloses an alternate piece that is a postcard (Column 1, Lines 58-63; Anderson).

In regards to Claim 17, as applied to Claim 15, Graushar modified by Anderson further discloses the pre-personalized book includes pre-personalized information and the alternate piece includes the same pre-personalized information of the pre-personalized book (Column 1, Lines 58-63; Anderson).

In regards to Claim 18, as applied to Claim 15, Graushar modified by Anderson further discloses wherein the pre-personalized book includes pre-personalized information, and the alternate piece includes the same pre-personalized information of

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the pre-personalized book. Graushar inherently teaches this because the generic book does not have the pre-personalized signatures but since it does go to a particular individual it will have address information for the customer. Since it does not have all the pre-personalized information but does have pre-personalized information, it is different pre-personalized information.

In regards to Claim 19, as applied to Claim 15, Graushar modified by Anderson further discloses the alternate piece is a printed product (Column 1, Lines 58-63; Anderson).

In regards to Claim 29, Graushar does not disclose the alternate piece is generated on the binding line.

Anderson discloses that it is well known to generate a mailing list of recipients; to generate a pre-personalized book on a binding line for a specific individual; rejecting selective pre-personalized books; and generating an alternate piece, on the binding line, in place of each rejected pre-personalized book to be delivered to the specific individual (Column 1, Lines 37 – 65). Furthermore Anderson discloses that certain feeders can be associated with particular books and that is how particular books are made for a person (Column 5, Lines 47 – 52). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to allow generation of the generic book using the particular feeders of Graushar in order to provide an alternate piece and series of pre-personalized books in one process.

2. Claims 9 – 12 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Graushar.

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In regards to Claim 9, Anderson discloses that it is known in the art to generate a mailing list of recipients; generate a pre-personalized book for each recipient on a binding line; rejecting one of the pre-personalized books; identifying the recipient of the [each] rejected pre-personalized book; and generating an alternate piece for each rejected pre-personalized book (Column 1, Lines 37-65).

Anderson does not disclose that the alternate piece includes a notification to the recipient regarding the status their pre-personalized book.

In regards to Claim 1, Graushar discloses a binding method comprising: generating a pre-personalized book on a binding line for a specific individual (Column 2, Lines 50 – 52); rejecting selective pre-personalized books (Column 2, Lines 66 – 67 → Column 3, Lines 1; and putting an alternate piece that replaces the rejected pre-personalized book and notifies the recipient of the status (obviously delayed) since it is generic and not personalized (Column 3, Lines 1 – 4). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a generic book as an alternate piece in order to reduce complication and time consumption during production while still maintaining the mailing order.

In regards to Claim 10, as applied to Claim 9, Anderson modified by Graushar further discloses Anderson discloses the alternate piece is a printed product (Column 1, Lines 58-63; Anderson).

In regards to Claim 11, as applied to Claim 9, Anderson modified by Graushar further discloses Anderson discloses the pre-personalized book includes pre-

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personalized information and the alternate piece includes the same pre-personalized information (Column 1, Lines 58-63; Anderson).

In regards to Claim 12, as applied to Claim 9, Anderson modified by Graushar further discloses Anderson discloses the act of generating the alternate piece includes printing the alternate piece on the binding line (Column 1, Lines 58-63; Anderson).

In regards to Claim 31, Anderson discloses generation of a mailing list of recipients, on line assembly of pre-personalized books for each recipient, rejecting selected books and then replacing them (Column 1, Lines 48-65; Anderson) and a replacement that is either a regenerated book identical to what the rejected book should have been or, the generation of an alternate piece (any piece that is not the original is alternate) (Column 1, Lines 58 – 64; Anderson).

Anderson does not disclose the ability to do several different replacements or the replacement with a generic book or alternate format piece.

Graushar discloses the replacement of a rejected book with a generic book which also acts as an alternate format piece (Column 2, Lines 50 – 67; Column 3, Lines 1 – 4). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to enable Anderson to allow for the feeding of a generic and alternate piece in addition to an identical replacement for different book rejections in order to allow for a backup rejection piece in case another fails or becomes unavailable and in light of failure or unavailability a magazine replacing a book or book replacing a magazine is also seen as a different medium.

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3. Claims 8, 14, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable in further view of Pace et al (Pace; U.S. 5,713,605).

In regards to Claim 8, as applied to Claim 1, Graushar modified by Anderson does not disclose the alternate piece is in electronic format.

Pace discloses a compact disk insert 50 containing a disk for binding compact disks into a bound publication without the need for specialized insert and binding machinery (Column 1, Lines 47 – 65; Figure 1, Item 50). Pace further discloses it is well known to have various forms of information on the compact disks (Column 1, Lines 9 – 17). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Pace's insert in Graushar's generic book in order to make the generic book more appealing to the customer.

In regards to Claim 14, as applied to Claim 9, Anderson modified by Graushar does not disclose the alternate piece is in electronic format.

Pace discloses a compact disk insert 50 containing a disk for binding compact disks into a bound publication without the need for specialized insert and binding machinery (Column 1, Lines 47 – 65; Figure 1, Item 50). Pace further discloses it is well known to have various forms of information on the compact disks (Column 1, Lines 9 – 17). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Pace's insert in Anderson modified by Graushar in order to make the alternate piece more appealing to the customer.

In regards to Claim 20, as applied to Claim 15, Graushar modified by Anderson does not disclose the alternate piece is in electronic format.

Pace discloses a compact disk insert 50 containing a disk for binding compact disks into a bound publication without the need for specialized insert and binding machinery (Column 1, Lines 47 – 65; Figure 1, Item 50). Pace further discloses it is well known to have various forms of information on the compact disks (Column 1, Lines 9 – 17). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Pace's insert in Graushar's generic book in order to make the generic book more appealing to the customer.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Graushar and Clark.

In regards to Claim 13, as applied to Claim 9, Anderson modified by Graushar does not disclose that generation of the alternate piece is done off-line with respect to the binding line.

Clark discloses an off-line printing option that will print an alternate piece for each rejected pre-personalized book (Column 2, Lines 22-27). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Anderson and Graushar's method to include the use of Clark's off-line printing to provide the ability to use the same pre-personalized information in order to possibly inform the recipient they will be receiving their book later, to reduce the cost of using the book generating machine, and also possibly save on labor costs.

5. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Clark (U.S. 5,428,423).

In regards to Claim 26, as applied to Claim 24, Anderson does not disclose how to make the alternate piece's information different from the books pre-personalized information.

Clark discloses a printer which takes input information and will print the same information onto an alternate piece. The information can be customized so, it be the same or different from the pre-personalized information of the book (Column 2, Lines 22-27). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to alter Anderson's method to include the use of Clark's printing method to provide the ability to alter the pre-personalized information in order to possibly inform the recipient they will be receiving their book later, to reduce the cost of using the book generating machine, and also possibly save on labor costs.

Response to Arguments

Applicant's arguments filed May 16, 2007 with respect to Claims 1 - 14, have been fully considered but they are not persuasive and are also moot in view of the new rejection. In regards to the alternate medium the applicant has not properly disclosed in the specification what defines a different medium (Page 5, Lines 14 – 23; Spec) and the specification only requires that the alternate piece be of a format different from the pre-personalized piece. A different medium can simply mean a different substrate or a different signature or different book wherein Graushar teaches of a generic book and therefore it is a different medium since it is not totally pre-personalized.

Applicant's arguments filed May 16, 2007 with respect to Claims 15 – 20, have been fully considered but they are not persuasive and are also moot in view of the new

rejection. Graushar discloses an alternate piece of a different format since the replacement is a generic book and not personalized. Furthermore, position 27 where the book is inserted to maintain mailing order is still on the binding line (Figure 1, Item 27; Graushar).

Applicant's arguments filed May 16, 2007 with respect to Claims 21 – 23, have been fully considered but they are not persuasive and moot in view of the new rejection. In regards to the alternate medium the applicant has not properly disclosed in the specification what defines a different medium (Page 5, Lines 14 – 23; Spec) and the specification only requires that the alternate piece be of a format different from the pre-personalized piece. A different medium can simply mean a different substrate or a different signature(s) or different book wherein Graushar teaches of a generic book and therefore it is a different medium since it is not totally pre-personalized. The Applicant cited passage of the specification only discloses the types of media and does not specify anything regarding a medium. Furthermore, as also disclosed by the Applicant, Graushar discloses it is **optional** to have all of the same signatures and inserts as the original book but it is not required and for the reasons above, it is a different book of a different medium. With respect to Graushar not disclosing the generating an alternate piece in place of each rejected book, the alternate piece is generated somehow, that is how it exists; however, applicant has failed to claim how the book is generated.

Applicant's arguments filed May 16, 2007 with respect to Claims 24 - 26, have been fully considered but they are not persuasive. With respect to Anderson failing to teach or suggest a binding method in which a per-personalized signature is reprinted for

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a specific individual's magazine after the original magazine with the specific individual's original pre-personalized signature is rejected; Anderson does teach of an identical magazine is remade and therefore has pre-personalized signatures. Furthermore, it is inherent magazines will have an address printed on them, and therefore the identical magazine will have the address reprinted on the address portion and it is not reasonable to infer the feeders have several address signatures corresponding to each customer.

Applicant's arguments with respect to Claims 28 – 30 have been considered but are moot in view of the new ground(s) of rejection. With respect to the argument of the medium, please refer to the previous responses for the argument of the alternate piece being of a different medium.

Applicant's arguments filed May 16, 2007 with respect to Claim 31, have been fully considered but they are not persuasive and moot in view of the new rejection. With respect to the different medium please review the rejection and the previous responses to Applicant's arguments.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Monday - Thursday 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PCB
Patent Examiner
July 26, 2007

Monica S. Carter
MONICA CARTER
SUPERVISORY PATENT EXAMINER